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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/646,150

08/22/2003

Sheldon H. Foss JR.

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02/17/2011

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EXAMINER

ROSEN, ELIZABETH H

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/646,150
Filing Date: August 22, 2003
Appellant(s): FOSS ET AL.

Adam E. Crall (Reg. No. 46,646)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 2, 2011 appealing from the Office action mailed February 22, 2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

1-4, 6, 8-11, 13, and 15-23

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112, First Paragraph

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make

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and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. **Claims 1-4, 6, 8-11, 13, and 15-23** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. These claims have been amended to include a processing system. Because the specification does not include any description of the claimed invention being performed by a processing system, this is new matter.

3. There is no indication in the specification that this invention is to be performed by a processing system. Likewise, the specification filed with the provisional application (60/466,494) does not explain the invention being performed by a processing system. However, a document that was filed with the provisional application does include a computer. Page 17 of this document states that "[t]he James/ Foss system is a collection of integrated computer softwares and proprietary algorithms, methods of work, business processes, and risk models that enable the analysis/issuance/distribution/monitoring of an integrated credit product that extends credit through host based stored value and an unsecured credit line." Page 17 further states "[t]he James/Foss system gives the service provider the ability to underwrite and integrate an extension of credit to a consumer through purchase/acquisition of a host based stored value or financial transaction vehicle." The page further includes a drawing that has a processing system. Nowhere does this document suggest that a computer or

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processor is used to perform the claimed invention. Furthermore, the specification of the non-provisional application does not refer to this document or explain how the computer shown in this document performs the claimed invention. In order for the provisional and non-provisional applications to include sufficient support for amendments made for 35 U.S.C. 101, they must describe the claimed embodiments as being performed by a computer or processor. More specifically, with regard to the method claims, the inventive features must be performed by a computer or processor. The mere mention of a computer that is used to perform non-claimed tasks is insufficient to provide support for the claims.

(10) Response to Argument

Appellant argues that the rejection under the first paragraph of 35 U.S.C. 112 is improper. In previous Office Actions, the claims were rejected under 35 U.S.C. 101. To overcome this rejection, Appellant amended the claims to include limitations such as a processing system. However, these amendments were not supported by the specification. Therefore, the claims were rejected under the first paragraph of 35 U.S.C. 112 for including new matter.

As explained in the rejection, neither the specification nor the provisional application discloses that the claimed invention is performed on a processing system. The only reference to a computer is in a document that was filed with the provisional application. However, this document does not include a processing system that performs the claimed invention. Therefore, it is clear that there is not explicit support for

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the amendments that were made to the claims. Furthermore, the processing system in the claims is not inherently disclosed in the original application. "To establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted). The specification does not explain whether the invention is to be performed by hand or by a machine. It would be improper to assume that the invention may be performed by a processing system when the original application does not make such an assertion. While it is possible to perform an invention such as the claimed invention on a machine, it is not inherent in the specification that a machine such as a processing system does perform the claimed invention. Accordingly, the claims include new matter.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Elizabeth H Rosen/

Examiner, Art Unit 3684

Conferees:

Kambiz Abdi /K. A./
Supervisory Patent Examiner, Art Unit 3684

Vincent Millin /vm/
Appeals Practice Specialist